

REMARKS

Claims 40-60 are pending in the Application.

Claims 40-60 stand rejected.

Claims 43, 53, 56 and 60 are hereby cancelled.

Applicants greatly appreciate the Examiner's time and effort in discussing the rejections with Applicants' attorney. The Examiner was quite helpful in making suggestions for overcoming the various rejections, including the submission of drawings to overcome the objections to the drawings, and the discussion of how to overcome the § 112 claim rejections.

Applicants respectfully assert that the amendments to the claims are not narrowing amendments made for a reason related to statutory requirements for a patent that will give rise to prosecution history estoppel. Furthermore, the amendments to the claims wherein the "typical caller ID" language was replaced was done merely to overcome a rejection by the Examiner who has asserted that the term "typical" is indefinite. Applicants disagree with such an assertion by the Examiner, but nevertheless have amended the claims to get past this impasse.

I. DRAWINGS

The Examiner has objected to the drawings under 37 C.F.R. 1.83(a) asserting that the "first caller ID modem" and "second caller ID modem" must be shown in the drawings. The Examiner agreed with Applicants' attorney that this objection could be overcome by modifying the drawings to include the caller ID modems recited within the claims.

The first caller ID modem is included within an analog telephone extension. Such an analog telephone extension is shown in FIGURE 13 as analog phone 1300. Analog phone 1300 uses a built-in caller ID modem, as noted in the Specification on page 26, line 1. Since such caller ID modems are built into the illustrated analog phone 1300, they were not shown, since they can be typical caller

ID modems such as shown in FIGURE 5. Nevertheless, Applicants have modified FIGURE 13 to include the caller ID modem 1302 in redline format as shown on the attached modified drawing sheet.

With respect to the other recited caller ID modem, Applicants have amended FIGURE 3 to include caller ID modem 351 in DSP 309, and have accordingly amended the Specification as shown above. Applicants respectfully assert that these modifications to the Specification and the drawings do not add new matter, since such caller ID modems were already disclosed as existing with respect to these portions of the system.

Regarding the objection to the drawings with respect to the "voicemail system" recited in claim 60, Applicants have cancelled claim 60 without prejudice, thus reserving the right to reinsert this claim at a later time. Applicants respectfully assert that the voicemail system is shown in the figures as a combination of several depicted items, such as the DSP 102 in FIGURE 1 and the recording and play buffers shown in FIGURE 5.

II. REJECTIONS UNDER 35 U.S.C. § 112

Claims 40-60 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. More specifically, the Examiner has asserted that the term "typical on line 15, page 40 is not clearly defined." However, the Examiner does admit that the term "typical caller ID information" is adequately described; the Examiner solely considers the term "typical" as indefinite. Correspondingly, with respect to claims 55 and 57, the Examiner also considers the term "non-typical" indefinite.

Applicants appreciate the Examiner agreeing that the "typical caller ID information" type language in the claims could be replaced with the definition provided in the Specification, and within claims 43, 53 and 56 where typical caller ID information within each of these claims is replaced with language from dependent claims. For example, claim 40 is now amended to incorporate the language

of claim 43, claim 49 is amended to incorporate the language of claim 53, and claim 55 is amended to incorporate the language of claim 56.

Though Applicants still believe that the term "typical" was not indefinite, it is now believed that claims 40-59 are in a condition that overcomes the § 112 rejection of the Examiner.

With respect to claim 52, Applicants have amended this claim simply to overcome the antecedent basis problem.

With respect to the rejections of claim 40 and 49 under 35 U.S.C. § 112, first paragraph, the Examiner has suggested that Applicants amend the Specification to reflect the storing circuitry language recited within these claims. Applicants have amended the Specification accordingly.

Claim 60 has been cancelled thus rendering moot the 35 U.S.C. § 112, first paragraph rejection of this claim.

With respect to claim 52, as being rejected under 35 U.S.C. § 112, first paragraph, as described to the Examiner by Applicants' attorney, Applicants respectfully traverse this rejection. The sending step of claim 49 is not merely represented by step 1204, but includes steps 1204-1207. Steps 1204-1207 are performed in order to pass the message to the caller ID modem 1302 in telephone 1300. The sending step of claim 52 is thus represented in FIGURE 12 by step 1206.

III. REJECTIONS UNDER 35 U.S.C. § 103:

Claims 40-44, 49-56 and 58 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Chang et al.* (U.S. Patent No. 5,771,283), and in view of *Gordon* (U.S. Patent No. 6,337,898), and *Chen* (U.S. Patent No. 5,930,346). In response, Applicants respectfully traverse these rejections.

In these rejections, the Examiner is relying upon the teachings in *Chang* of the GID as representing the message that does not include typical caller ID information. Applicants respectfully assert that the Examiner is relying upon an incorrect factual predicate in relying upon such teachings

in *Chang*. *In re Rouffet*, 47 U.S.P.Q. 2d 1453, 1455 (Fed. Cir. 1998). *Chang* specifically teaches that the GID is provided along with a caller's directory number. Column 2, lines 6-7. *Chang* specifically recites that the delivered caller ID service includes the GID in conjunction with the caller's directory number, to a called party. Column 2, lines 34-36. Claims 40, 49, and 55 all recite that the message does not include a phone number of the caller. Thus, *Chang* teaches away from the claims of the present invention. In fact, the Examiner admits to such a teaching in *Chang* on page 7 of Paper No. 11 where the Examiner asserts that *Chang* teaches in column 6, line 14 of *Chang* that the caller's directory number is included.

Further, the Examiner admits that *Gordon* teaches in column 5, lines 31-33 that it includes the calling name of the caller, which is opposite of the recited claims.

Claims 45-46, 48 and 60 stand rejected under 35 U.S.C. § 103 as being unpatentable over *Chang*, *Gordon* and *Chen* as stated in claim 42, and in view of *Wilson et al.* (U.S. Patent No. 5,838,772). In response, Applicants respectfully traverse these rejections for the same reasons as given above.

Applicants also respectfully assert that claims 47, 57, and 59 are also patentable over the rejections given on pages 9 and 10 of Paper No. 11 for the same reasons as given above, since the Examiner has relied upon *Chang* and *Gordon*.

IV. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that the remaining claims in the Application are in condition for allowance, and respectfully request an early allowance of such claims.

Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining problems.

Respectfully submitted,

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